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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/223,347	12/30/1998	PIERRE BIERRE	P-4286	1754

7590 12/18/2001

RICHARD J RODRICK
BECTON DICKINSON AND COMPANY
ONE BECTON DRIVE
FRANKLIN LAKES, NJ 074171880

EXAMINER

CROSS, LATOYA I

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 12/18/2001

17

Please find below and/or attached an Office communication concerning this application or proceeding.

MF-17

Office Action Summary

Application No.

09/223,347

Applicant(s)

BIERRE ET AL.

Examiner

LaToya I. Cross

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

This Office Action is in response to Applicants' amendments filed on October 5, 2001 and the supplemental amendment filed on October 12, 2001. Claims 33-50 are pending in the application. Claims 1, 3, 4, and 32 were canceled by amendment.

Claim Rejections - 35 USC § 103

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 33-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 4,842,153 to Hulon (hereinafter to as Hulon '153) in view of U.S. Patent 5,609,778 to Pulaski et al (hereinafter Pulaski et al '778).

Hulon '153 discloses a container for holding biological samples. The container comprises a first tubular section having a closed end, and a second tubular section which is integrally connected to the first tubular section (abstract). The outer tubular section has identification information integrally imprinted on the exterior surface to help in identifying the contents and other essential information concerning the sample (col. 3, lines 15-17; col. 4, line 66 - col. 5, line 5). The sample container of Hulon '153 is manufactured from strong plastic material (col. 7, lines 26-40).

Hulon '153 differ from the instantly claimed invention in that while Hulon '153 does disclose identifying information imprinted on the outer surface of the container, there is no disclosure of differing specular reflectances on the outer wall of the container due to the presence of the identifying information.

Pulaski et al '778 teach a process for high contrast marking on surfaces using lasers, whereby micro-reflectors are formed on the surfaces being marked. The surface markings may be applied to glass or plastic surfaces of containers. Pulaski et al '778 disclose prior art markings which were inferior since they could be removed during shipping or handling processes. The reference teaches the advantages of using laser markings which would prevent removal of the marks and allow for containers to be marked with specialized information. See col. 1, lines 49-57 and col. 2, lines 51-53. At col. 3, lines 51-55, Pulaski et al '778 teach the use of laser beams for directly marking or engraving the surface.

It would have been obvious to one of ordinary skill in the art to use the concepts of laser etching and specular reflectance on the container provided by Hulon '153 since the identification process of Pulaski et al '778 would provide a more accurate manner for labeling biological samples and a manner in which the labeling may not be tampered with. Use of such a process would allow for easy identification of the containers.

Therefore, for the reasons set forth above, Applicants' claimed invention is deemed to be obvious within the meaning of 35 U.S.C. 103 in view of the teachings of Hulon '153 and Pulaski et al '778.

Response to Arguments

3. Applicant's arguments filed March 13, 2001 have been fully considered but they are not persuasive. Applicants' arguments concerning the rejection over Hulon '153 in

Art Unit: 1743

view of Pulaski et al '778 are directed to the fact that neither reference specifically teaches a "universally" unique identifier that can be used across institutional or organizational borders. In response, Pulaski et al '778 teach the use of bar codes to label the containers and provide identification information about the sample contained therein. For the most part, bar codes are identifiers based on the Universal Product Code (UPC), especially those products that are labeled at the time of manufacturing. UPC is a well-known means for labeling products with uniquely identifiable information and contains information about the product itself. It is submitted that the skilled artisan would have been able to use a container having a universal identification system, such as UPC, where samples need to be identified outside of the institution/organization. The use of such a system does not appear to impart patentability to the claimed invention.

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of


the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaToya I. Cross whose telephone number is (703) 305-7360. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden, can be reached at (703) 308-4073. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5408.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

LIC
December 15, 2001


Jill Warden
Supervisory Patent Examiner
Technology Center 1700